

REMARKS

In accordance with the foregoing, the specification and claim 23 have been amended, and new claims 25-27 have been added. Claims 1-27 are pending, with claims 1, 19, and 23 being independent. No new matter is presented in this Amendment.

Request for Interview Prior to Issuance of Next Office Action

As discussed in detail below, claims 1-24 have been rejected under 35 USC 102(e) as being anticipated by claims 1-24 of Lamkin et al. (Lamkin '729) (U.S. Patent Application Publication No. 2005/0278729), which was filed on July 12, 2005, as a continuation of an earlier application. However, claims 1-24 of Lamkin '729 were copied from claims 1-24 of the present application, and are not supported by the earlier application of which Lamkin '729 purports to be a continuation. Thus, Lamkin '729 in fact is a continuation-in-part of the earlier application, and the effective U.S. filing date of claims 1-24 of Lamkin '729 is July 12, 2005, which is after the U.S. filing date of October 16, 2003, of the present application, such that 1-24 claims of Lamkin '729 cannot anticipate claims 1-24 of the present application as alleged by the Examiner. However, should the Examiner disagree, it is respectfully requested that the Examiner contact the undersigned attorney to schedule an interview to discuss this matter prior to issuing the next Office Action.

Drawing Objections

FIGS. 1, 2, and 12 have been objected to as failing to conform to 37 CFR 1.84(p)(1) and 37 CFR 1.84(q), and FIGS. 2 and 12 have been objected to as failing to conform to 37 CFR 1.84(p)(3). However, the Examiner did not identify the alleged deficiencies in FIGS. 1, 2, and 12 that make these figures fail to comply with the portions of 37 CFR 1.84 referred to by the Examiner, thereby making it impossible for the applicants to respond to the objection without speculating about what changes to FIGS. 1, 2, and 12 the Examiner considers to be necessary to overcome the objection.

37 CFR 1.84(p)(1) provides as follows:

(1) Reference characters (numerals are preferred), sheet numbers, and view numbers must be plain and legible, and must

not be used in association with brackets or inverted commas, or enclosed within outlines, e.g., encircled. They must be oriented in the same direction as the view so as to avoid having to rotate the sheet. Reference characters should be arranged to follow the profile of the object depicted.

37 CFR 1.84(p)(3) provides as follows:

(3) Numbers, letters, and reference characters must measure at least .32 cm. (1/8 inch) in height. They should not be placed in the drawing so as to interfere with its comprehension. Therefore, they should not cross or mingle with the lines. They should not be placed upon hatched or shaded surfaces. When necessary, such as indicating a surface or cross section, a reference character may be underlined and a blank space may be left in the hatching or shading where the character occurs so that it appears distinct.

37 CFR 1.84(q) provides as follows:

(q) *Lead lines.* Lead lines are those lines between the reference characters and the details referred to. Such lines may be straight or curved and should be as short as possible. They must originate in the immediate proximity of the reference character and extend to the feature indicated. Lead lines must not cross each other. Lead lines are required for each reference character except for those which indicate the surface or cross section on which they are placed. Such a reference character must be underlined to make it clear that a lead line has not been left out by mistake. Lead lines must be executed in the same way as lines in the drawing. See paragraph (l) of this section.

As can be seen, 37 CFR 1.84(p)(1), 37 CFR 1.84(p)(3), and 37 CFR 1.84(q) contain many different requirements. Accordingly, it is respectfully requested that the Examiner identify the alleged deficiencies in FIGS. 1, 2, and 12 that make these figures fail to comply with these portions of 37 CFR 1.84 so that the applicants can respond to the objection without speculating about what changes to FIGS. 1, 2, and 12 the Examiner considers to be necessary to overcome the objection.

Double Patenting Rejections

Amending the Claims or Filing a Terminal Disclaimer Would Be Premature

The Examiner has set forth five obviousness-type double patenting rejections in which the Examiner has provisionally rejected claim 1 of the present application over various claims of copending Application Nos. 10/685,694, 10/685,696, 10/685,697, 10/685,699, and 10/686,537. As indicated by the Examiner, these provisional rejections can be overcome by filing a terminal disclaimer. However, as recognized by the Examiner, the claims of the five copending applications relied on by the Examiner have not in fact been patented. In light of this, it is submitted that it would be premature for the applicants to amend the claims of the present application or file a terminal disclaimer in response to the provisional rejections because it is impossible to know at this time whether the claims of the five copending applications relied on by the Examiner will ever be patented. Accordingly, it is respectfully requested that the provisional obviousness-type double patenting rejections be held in abeyance until the five copending applications have issued as patents.

Rejection 1

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-9 of copending Application No. 10/685,694. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because claims 7-9 of the copending application [No. 10/685,694] anticipate claim 1 of Application No. 10/686,521 [the present application]."

Claim 1 of the present application reads as follows:

1. An apparatus for reproducing audio video (AV) data using a markup document in an interactive mode, comprising:
 - a buffer which buffers the markup document; and
 - a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal.

In contrast, independent claim 1 and claims 7-9 depending therefrom of copending Application No. 10/685,694 read as follows:

1. An apparatus for reproducing AV data using a markup document in an interactive mode, comprising:
 - a buffer which buffers the markup document;
 - a content decoder which interprets the markup document;and
 - a buffer manager which manages the buffer to preload the markup document and informs the content decoder of whether preloading of the markup document is completed.
7. The apparatus of claim 1 further comprising a content decoder which interprets the markup document, wherein the content decoder checks whether preloading of the markup document is completed using an API.
8. The apparatus of claim 7, wherein the API is an [obj].allDone API.
9. The apparatus of claim 8, wherein the [obj].allDone API returns a value of true to the content decoder where the preloading of the markup document is completed and returns a value of false to the content decoder where the preloading of the markup document is not completed.

However, it is submitted that the Examiner's explanation of this rejection does not comply with the requirements of an obviousness-type double patenting rejection set forth in MPEP 804(II)(B)(1), which provides as follows on MPEP pages 800-21 and 800-22 (emphasis by underlining added):

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

(A) Determine the scope and content of a patent claim relative to a claim in the application at issue;

(B) Determine the differences between the scope and content of the patent claim as determined in (A) and the claim in the application at issue;

(C) Determine the level of ordinary skill in the pertinent art;
and

(D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations. Any obviousness-type double patenting rejection should make clear:

(A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and

(B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim at issue is anticipated by, or would have been an obvious variation of, the invention defined in a claim in the patent.

Here, the Examiner's explanation of this rejection does not make clear the differences between claims 7-9 of copending Application No. 10/685,694 and claim 1 of the present application, or the reasons why a person of ordinary skill in the art would conclude that the invention defined in claim 1 of the present application, which recites "a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal," is anticipated by claims 7-9 of copending Application No. 10/685,694. Accordingly, it is submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting with respect to this rejection pursuant to MPEP 804(II)(B)(1) referred to above.

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-9 of copending Application No. 10/685,694 be withdrawn.

Rejection 2

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/685,696. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because using the data storage medium of claim 3 of the copending application [No. 10/685,696] anticipates claim 1 of

Application No. 10/686,521 [the present application]," and that "[u]sing the data storage medium requires an apparatus."

Claim 1 of the present application reads as follows:

1. An apparatus for reproducing audio video (AV) data using a markup document in an interactive mode, comprising:
 - a buffer which buffers the markup document; and
 - a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal.

In contrast, independent claim 1 and claim 3 depending therefrom of copending Application No. 10/685,696 read as follows:

1. A data storage medium encoded with program codes for enabling a method of reproducing AV data in an interactive mode using markup documents, performed by a computer, the data storage medium comprising:
 - a first program code to carry out buffering of the markup documents to preload the markup documents; and
 - a second program code to output information indicating whether the buffering of the markup documents is completed.
3. The data storage medium of claim 1, wherein the second program code is executed in response to an application program interface (API) inquiring whether the buffering of the markup documents is completed.

Here, the Examiner's explanation of this rejection does not make clear the differences between claim 3 of copending Application No. 10/685,696 and claim 1 of the present application, or the reasons why a person of ordinary skill in the art would conclude that the invention defined in claim 1 of the present application, which recites "a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal," is anticipated by claim 3 of copending Application No. 10/685,696. Accordingly, it is submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting with respect to this rejection pursuant to MPEP 804(II)(B)(1) referred to above.

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 3 of copending Application No. 10/685,696 be withdrawn.

Rejection 3

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/685,697. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because using the data storage medium of claim 17 of the copending application [No. 10/685,697] anticipates claim 1 of Application No. 10/686,521 [the present application]," and that "[u]sing the data storage medium requires an apparatus."

Claim 1 of the present application reads as follows:

1. An apparatus for reproducing audio video (AV) data using a markup document in an interactive mode, comprising:
 - a buffer which buffers the markup document; and
 - a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal.

In contrast, claim 17 of copending Application No. 10/685,697 reads as follows:

17. A computer readable medium encoded with operating instructions for implementing a method of reproducing AV data in an interactive mode using markup document, performed by a computer, the method comprising:
 - buffering the markup document to preload the markup document; and
 - outputting buffering state information of the markup document in response to a report signal.

As pointed out by the Examiner, this provisional rejection can be overcome by filing a terminal disclaimer. However, it is submitted that filing such a terminal disclaimer would be

premature at this time both for the reasons discussed above and for the reasons discussed in MPEP 804(I)(B)(1), which provides as follows on MPEP page 800-17:

If "provisional" ODP [obviousness-type double patenting] rejections in two applications are the only rejections remaining in those applications, the examiner should withdraw the ODP rejection in the earlier filed application thereby permitting that application to issue without need of a terminal disclaimer. A terminal disclaimer must be required in the later-filed application before the ODP rejection can be withdrawn and the application permitted to issue. If both applications are filed on the same day, the examiner should determine which application claims the base invention and which application claims the improvement (added limitations). The ODP rejection in the base application can be withdrawn without a terminal disclaimer, while the ODP rejection in the improvement application cannot be withdrawn without a terminal disclaimer.

Here, there are other rejections remaining in the present application, and an Office Action has not yet been issued in copending Application No. 10/685,697, which is currently docketed to Examiner Christopher C. Grant in Art Unit 2623 but has not yet been acted on. Also, the present application and copending Application No. 10/685,697 were both filed on October 16, 2003, and the Examiner has not yet made a determination as to which application claims the base invention and which application claims the improvement, such that the applicants do not yet know whether to file a terminal disclaimer in the present application or in copending Application No. 10/685,697.

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 17 of copending Application No. 10/685,697 be held in abeyance at least until the conditions set forth in MPEP 804(I)(B)(1) referred to above have been satisfied.

Rejection 4

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 9 of copending Application No. 10/685,699. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because using the data storage medium of claim 9 of the copending application [No. 10/685,699] anticipates claim 1 of Application No. 10/686,521 [the present application]," and that "[u]sing the data storage medium requires an apparatus."

Claim 1 of the present application reads as follows:

1. An apparatus for reproducing audio video (AV) data using a markup document in an interactive mode, comprising:
 - a buffer which buffers the markup document; and
 - a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal.

In contrast, claim 9 of copending Application No. 10/685,699 reads as follows

9. A computer readable medium encoded with operating instructions for implementing a method of reproducing AV data in an interactive mode using markup document, performed by a computer, the method comprising:
 - inquiring whether preloading of the markup document is completed using an application program interface (API); and
 - receiving a return value of true in response to the preloading of the markup document being completed and a return value of false in response to the preloading of the markup document being not completed.

Here, the Examiner's explanation of this rejection does not make clear the differences between claim 9 of copending Application No. 10/685,699 and claim 1 of the present application, or the reasons why a person of ordinary skill in the art would conclude that the invention defined in claim 1 of the present application, which recites "a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal," is anticipated by claim 9 of copending Application No. 10/685,699. Accordingly, it is submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting with respect to this rejection pursuant to MPEP 804(II)(B)(1) referred to above.

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 5 of copending Application No. 10/685,699 be withdrawn.

Rejection 5

Claim 1 has been provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/686,537. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states that "[a]lthough the conflicting claims are not identical, they are not patentably distinct from each other because using the data storage medium of claim 4 of the copending application [No. 10/686,537] anticipates the apparatus [of claim 1 of the present application]," and that "[u]sing the data storage medium requires an apparatus."

Claim 1 of the present application reads as follows:

1. An apparatus for reproducing audio video (AV) data using a markup document in an interactive mode, comprising:
 - a buffer which buffers the markup document; and
 - a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal.

In contrast, independent claim 1 and claim 4 depending therefrom of copending Application No. 10/686,537 read as follows

1. A data storage medium, comprising:
 - audio video (AV) data;
 - a markup document which was provided to reproduce the AV data in an interactive mode; and
 - control information which was provided to identify buffering state information of the markup document to be preloaded.
4. The data storage medium of claim 1, wherein the control information includes an API that returns a value of 0 in response to preloading of the markup document being successful, a value of 1 in response to the preloading of the markup document

being failed, and a value of 2 in response to the preloading of the markup document still being conducted.

Here, the Examiner's explanation of this rejection does not make clear the differences between claim 4 of copending Application No. 10/686,537 and claim 1 of the present application, or the reasons why a person of ordinary skill in the art would conclude that the invention defined in claim 1 of the present application, which recites "a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal," is anticipated by claim 4 of copending Application No. 10/686,537. Accordingly, it is submitted that the Examiner has not established a *prima facie* case of obviousness-type double patenting with respect to this rejection pursuant to MPEP 804(II)(B)(1) referred to above.

For at least the foregoing reasons, it is respectfully requested that the provisional rejection of claim 1 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 4 of copending Application No. 10/686,537 be withdrawn.

Claim Rejections Under 35 USC 112

Claims 19-24 have been rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicants regard as the invention. This rejection is respectfully traversed.

Claims 19-22

In explaining the rejection of claims 19-22, the Examiner states as follows:

Claims 19 – 22 recite an apparatus for controlling a buffer, but the apparatus does not appear to include the buffer. It appears that the elements of the apparatus, specifically the buffer manager, can be implemented in software alone. The claims do not appear to recite structural elements. Therefore, it is not clear that the claimed subject matter can be accurately described as an apparatus.

Claim 19 is independent, and claims 20-22 depend from claim 19. Claim 19 reads as follows:

19. An apparatus for controlling a buffer which buffers a markup document to reproduce audio video (AV) data in an interactive mode, comprising a buffer manager which manages the buffer to preload the markup document and outputs information of the buffer including buffering information of the markup document, wherein the buffering information includes:

information indicating that preloading of the markup document succeeded;

information indicating that the preloading of the markup document failed; and

information indicating that the preloading of the markup document is still be conducted.

Thus, claims 19-22 explicitly recite an apparatus comprising a buffer manager, which is clearly a structural element. Assuming *arguendo* that the elements of apparatus claims 19-22, specifically the buffer manager, can be implemented in software alone as conjectured by the Examiner, the language of claims 19-22 does not limit the elements to such a software only implementation, and it is submitted that the elements can also be implemented in hardware, or in a combination of hardware and software. Furthermore, even if the buffer manager were to be implemented in software alone, that software would be executed on a computer, microcontroller, or other type of processor, which would be an apparatus as recited in claims 19-22.

For at least the foregoing reasons, it is submitted that claims 19-22 do in fact recite structural elements, such that the subject matter claimed in claims 19-22 can in fact be accurately described as an apparatus, such that claims 19-22 are not indefinite as alleged by the Examiner.

Claims 23 and 24

In explaining the rejection of claims 23 and 24, the Examiner states as follows:

Claims 23 – 24 recite the term "ENAV". It is not clear if "enhanced audio and video" means "enhanced navigation."

. . . . The term "ENAV" in claims 23 and 24 is used by the claim to mean "enhanced audio and video", while the accepted meaning is "enhanced navigation." See Tsumagari et al. US 20030161615 A1 (¶ 58). The term is indefinite because the specification does not clearly redefine the term.

In accordance with the position taken by the Examiner, paragraphs [0022] and [0070] of the specification and independent claim 23, from which claim 24 depends, have been amended to indicate that "ENAV" means "enhanced navigation."

Conclusion—Claim Rejections Under 35 USC 112

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 19-24 under 35 USC 112, second paragraph, be withdrawn.

Claim Rejections Under 35 USC 101

Claims 19-22 were rejected under 35 U.S.C. 101 because, according to the Examiner, the claimed invention is directed to non-statutory subject matter. This rejection is respectfully traversed.

In explaining the rejection, the Examiner states as follows:

The claims recite an apparatus for controlling a buffer, but the apparatus does not appear to include the buffer. It appears that the elements of the apparatus, specifically the buffer manager, can be implemented in software alone, making the claims software, per se. Even though the claim states that the manager is part of an apparatus, it appears that the recited elements of the apparatus can be implemented in software alone. Therefore, the claims are rejected as being directed toward non-statutory subject matter.

Claim 19 is independent, and claims 20-22 depend from claim 19. Claim 19 reads as follows:

19. An apparatus for controlling a buffer which buffers a markup document to reproduce audio video (AV) data in an interactive mode, comprising a buffer manager which manages the buffer to preload the markup document and outputs information of the buffer including buffering information of the markup document, wherein the buffering information includes:

information indicating that preloading of the markup document succeeded;

information indicating that the preloading of the markup document failed; and

information indicating that the preloading of the markup document is still be conducted.

Clearly, claims 19-22 recite an apparatus, which falls under the statutory category of "machine" set forth in 35 USC 101. Assuming *arguendo* that the elements of apparatus claims 19-22 can be implemented in software alone as conjectured by the Examiner, it is submitted that this does not make claims 19-22 unpatentable under 35 USC 101 as being directed to non-statutory subject matter as alleged by the Examiner. It is submitted that nothing whatsoever in MPEP 2106 ("Patent Subject Matter Eligibility") (see MPEP pages 2100-5 through 2100-16) and MPEP 2106.1 ("Computer-Related Nonstatutory Subject Matter") (see MPEP pages 2100-17 and 2100-18) supports the position taken by the Examiner. Furthermore, it is submitted that nothing whatsoever in the Examiner's explanation of the rejection indicates that the Examiner has analyzed claims 19-22 in the manner required by MPEP 2106 and 2106.1. In any event it is submitted that the Examiner has not clearly communicated the findings, conclusions, and reasons which support his rejection of claims 19-22 under 35 USC 101 as being directed to non-statutory subject matter as required by MPEP 2106(VII) (see MPEP page 2100-15). Accordingly, it is submitted that the Examiner has not established a *prima facie* case of unpatentability under 35 USC 101.

The above arguments were also presented on pages 12 and 13 of the Amendment of March 9, 2007, but the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 6, 2007, as required by MPEP 707.07(f).

Rather, the Examiner merely states as follows on page 2 of the Office Action of June 6, 2007:

Applicant's arguments regarding rejections under 35 U.S.C. 101 have been fully considered but they are not persuasive. See current rejections under 35 U.S.C. 112, second paragraph, and 35 U.S.C. 101.

However, the Examiner's explanation of the rejection of claims 19-22 under 35 USC 101 in the Office Action of June 6, 2007, is identical to the Examiner's explanation of this rejection in the Office Action of December 12, 2006, to which the applicants responded with the above arguments in the Amendment of March 9, 2007.

Furthermore, as discussed above in connection with the rejection under 35 USC 112, second paragraph, assuming *arguendo* that the elements of apparatus claims 19-22, specifically the buffer manager, can be implemented in software alone as conjectured by the Examiner, the

language of claims 19-22 does not limit the elements to such a software only implementation, and it is submitted that the elements can also be implemented in hardware, or in a combination of hardware and software. Furthermore, even if the buffer manager were to be implemented in software alone, that software would be executed on a computer, microcontroller, or other type of processor, which would be an apparatus as recited in claims 19-22.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 19-22 under 35 USC 101 as being directed to non-statutory subject matter be withdrawn.

Claim Rejections Under 35 USC 102

Claims 1-24 were rejected under 35 USC 102(e) as being anticipated by Lamkin et al. (Lamkin '729) (U.S. Patent Application Publication No. 2005/0278729). This rejection is respectfully traversed.

Attached to the amendment of March 9, 2007, are copies of a Utility Patent Application Transmittal, a Fee Transmittal, and a Notice of Copied Claims Under 37 C.F.R. § 1.604(b) filed on July 12, 2005, in Lamkin '729. As can be seen from the Notice of Copied Claims, claims 1-24 of Lamkin '729 are identical to claims 1-24 of the present application because Lamkin '729 copied claims 1-24 of the present application as claims 1-24 of Lamkin '729. The present application is referred to by its publication number of 2004/0139394 in the Notice of Copied Claims.

Also, as can be seen from the Notice of Copied Claims, claims 25-33 of Lamkin '729 are identical to claims 1-9 of copending Application No. 10/685,694 because Lamkin '729 copied claims 1-9 of copending Application No. 10/685,694 as claims 25-33 of Lamkin '729. The inventors of the present application are also the inventors of copending Application No. 10/685,694. Copending Application No. 10/685,694 is referred to by its publication number of 2004/0139249 in the Notice of Copied Claims.

The actual U.S. filing date of Lamkin '729 is July 12, 2005, which is after the U.S. filing date of October 16, 2003, of both the present application and copending Application No. 10/685,694. Lamkin purports to be a continuation of Application No. 09/935,756 filed on August 21, 2001, which was published as U.S. Patent Application Publication No. 2002/0078144 to Lamkin et al. (Lamkin '144). However, it is submitted that copied claims 1-33 of Lamkin '729

appear to contain new matter with respect to parent Application No. 09/935,756 of Lamkin '729 at least because the terms "buffer manager," "report signal," and "preload" (in all its forms) recited in various ones of claims 1-24 of the present application and various ones of claims 1-9 of copending Application No. 685,694 appear only in various ones of copied claims 1-33 of Lamkin '729 and do not appear elsewhere in Lamkin '729 or anywhere in Lamkin '144 which is a publication of parent Application No. 09/935,756 of Lamkin '729. In light of this, it is submitted that Lamkin '729 is actually a continuation-in-part of parent Application No. 10/935,756 of Lamkin '729.

In any event, it is submitted that the Examiner cannot rely on any matter in Lamkin '729 (U.S. filing date of July 12, 2005) that does not appear in Lamkin '144 (U.S. filing date of August 21, 2001) which is a publication of parent Application No. 09/935,756 of Lamkin '729 because any such matter in Lamkin '729 has a U.S. filing date of July 12, 2005, which is after the U.S. filing date of October 16, 2003, of the present application. In particular, the Examiner cannot rely on any of claims 1-33 of Lamkin '729 to reject any of claims 1-24 of the present application because claims 1-33 of Lamkin '729 have a U.S. filing date of July 12, 2005, which is after the U.S. filing date of October 16, 2003, of the present application.

In light of this, it is submitted that the appropriate course of action would be for the Examiner to rely on Lamkin '144 to avoid the possibility of relying on any matter in Lamkin '729 that has a U.S. filing date of July 12, 2005. Accordingly, should the Examiner be inclined to continue to rely on Lamkin '729 in the next Office Action, it is respectfully requested that the Examiner rely on Lamkin '144 instead. Alternatively, should the Examiner decline to do this, it is respectfully requested that the Examiner specifically point out where any portions of Lamkin '729 relied on by the Examiner can also be found in Lamkin '144.

In any event, since the Examiner relied only on claims 1-24 of Lamkin '729 in the rejection of claims 1-24 under 35 USC 102(e) as being anticipated by Lamkin '729, and since claims 1-24 of Lamkin '729 have a U.S. filing date of July 12, 2005, which is after the U.S. filing date of October 16, 2003, of the present application, it is respectfully requested that the rejection of claims 1-24 under 35 USC 102(e) as being anticipated by claims 1-24 of Lamkin '729 be withdrawn.

The above arguments were also presented on pages 14 and 15 of the Amendment of March 9, 2007, but the Examiner did not take note of these arguments and answer the

substance of them in the Office Action of June 6, 2007, as required by MPEP 707.07(f).

Rather, the Examiner merely states as follows on page 2 of the Office Action of June 6, 2007:

Regarding Lamkin, the application was filed as a continuation.

However, the above arguments presented on pages 14 and 15 of the Amendment of March 9, 2007, already address the fact that Lamkin '729 purports to be a continuation, but argue that Lamkin '729 is actually a continuation-in-part. The Examiner has simply ignored these arguments in the Office Action of June 6, 2007.

The Examiner's position appears to be that since Lamkin '729 (the child Lamkin '729) was filed as a continuation of Application No. 09/935,756 filed on August 21, 2001, which was published as Lamkin '144 (the parent Lamkin '144), then copied claims 1-33 of the child Lamkin '729 are automatically entitled to the filing date of August 21, 2001, of the parent Lamkin '144. However, it is submitted that this is not in fact the case. The Examiner's attention is directed to MPEP 201.11(I)(B), which provides as follows on MPEP page 200-59 (emphasis by underlining added):

The disclosure of a continuation application must be the same as the disclosure of the prior-filed application. See MPEP § 201.07. The disclosure of a divisional application must be the same as the disclosure of the prior-filed application, or include at least that portion of the disclosure of the prior-filed application that is germane to the invention claimed in the divisional application. See MPEP § 201.06. The disclosure of a continuation or divisional application cannot include anything which would constitute new matter if inserted in the prior-filed application. A continuation-in-part application may include matter not disclosed in the prior-filed application. See MPEP § 201.08. Only the claims of the continuation-in-part application that are disclosed in the manner provided by the first paragraph of 35 U.S.C. 112 in the prior-filed application are entitled to the benefit of the filing date of the prior-filed application. If there is a continuous chain of copending nonprovisional applications, each copending application must disclose the claimed invention of the later-filed application in the manner provided by the first paragraph of 35 U.S.C. 112, in order for the later-filed application to be entitled to the benefit of the earliest filing date.

Under 35 U.S.C. 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the earlier

filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). A claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under 35 U.S.C. 120 since 35 U.S.C. 120 requires that the earlier filed application contain a disclosure which complies with 35 U.S.C. 112, first paragraph for each claim in the subsequently filed application. *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997).

Thus, if a continuing application that purports to be a continuation application includes something that would constitute new matter if inserted in the parent application, then the continuing application is in fact a continuation-in-part application. Here, it is submitted that copied claims 1-33 of the child Lamkin '729 would constitute new matter if inserted in the parent Lamkin '144 because there is no support in the parent Lamkin '144 for copied claims 1-33 of the child Lamkin '729 at least because the terms "buffer," "buffer manager," "preload," "preloading," "preloaded," "preloads," "fetch signal," and "[obj].allDone API" that appear in various ones of copied claims 1, 2, 4, 5, 8-12, 14-19, 20-23, and 25-33 of the child Lamkin '729 appear only in copied claims 1, 2, 4, 5, 8-12, 14-19, 20-23, and 25-33 of the child Lamkin '729 and do not appear anywhere else in the child Lamkin '729 or anywhere at all in the parent Lamkin '144. In light of this, it is submitted that the child Lamkin '729 is actually a continuation-in-part of the parent Lamkin '144.

The Examiner's attention is directed to MPEP 201.06(c)(III), which provides as follows on MPEP page 200-25 (emphasis by underlining added):

Where a copy of the oath or declaration from a prior application was filed in a continuation or divisional application, if the examiner determines that new matter is present relative to the prior application, the examiner should so notify the applicant in the next Office action (preferably the first Office action). The examiner should require: (A) a new oath or declaration along with the surcharge set forth in 37 CFR 1.16(f); and (B) that the application be redesignated as a continuation-in-part.

Here, a copy of the declaration from the parent Lamkin '144 was filed in the child Lamkin '729. Since claims 1-33 of the child Lamkin '729 are new matter relative to the parent Lamkin '144 at least for the reasons discussed above, it is submitted that the Examiner of the child Lamkin '729 will be required to require the applicants of the child Lamkin '729 to redesignate the

child Lamkin '729 as a continuation-in-part application. It is noted that the child Lamkin '729 has not yet been assigned to an Examiner.

In explaining the rejection of claims 1-24 on page 8 of the Office Action of December 12, 2006, and page 10 of the Office Action of March 9, 2007, the Examiner merely states that "claims 1 – 24 are taught by claims 1 – 24 of Lamkin."

Accordingly, it is submitted that the burden is on the Examiner of the present application, who is relying on copied claims 1-24 of the child Lamkin '729 as a reference against claims 1-24 of the present application, to determine whether copied claims 1-24 of the child Lamkin '729 are in fact entitled to the filing date of August 21, 2001, of the parent Lamkin '144 pursuant to MPEP 706.02(V), which provides as follows on MPEP page 700-23 (emphasis by underlining added):

The effective filing date of a U.S. application may be determined as follows:

...

(B) If the application is a continuation-in-part of an earlier U.S. application or international application, any claims in the new application not supported by the specification and claims of the parent application have an effective filing date equal to the filing date of the new application. Any claims which are fully supported under 35 U.S.C. 112 by the earlier parent application have the effective filing date of that earlier parent application.

Here, since copied claims 1-33 of the child Lamkin '729 would constitute new matter if inserted in the parent Lamkin '144 at least for the reasons discussed above, it is submitted that copied claims 1-33 of the child Lamkin '729, which include copied claims 1-24 of the child Lamkin '729 relied on by the Examiner in the rejection of claims 1-24 of the present application over the child Lamkin '729, are not supported by the parent Lamkin '144, and thus have an effective filing date that is the filing date of the child Lamkin '729, i.e., July 12, 2005, which is after the filing date of October 16, 2003, of the present application, such that copied claims 1-24 of the child Lamkin '729 cannot be used as a reference against claims 1-24 of the present application. Should the Examiner disagree, it is respectfully requested that the Examiner explain in detail why he considers copied claims 1-24 of the child Lamkin '729 to be supported by the parent Lamkin '144 in light of the detailed arguments presented above in which the applicants have pointed out why there is no such support.

Furthermore, the Examiner's attention is directed to MPEP 2304.02(d), which provides as follows on MPEP page 2300-25 (emphasis by underlining added):

An applicant is not entitled to an interference simply because applicant wants one. The interfering claim must be allowable, particularly with respect to the written description supporting the interfering claim.

Historically, an applicant provoked an interference by copying a claim from its opponent. The problem this practice created was that differences in the underlying disclosures might leave the claim allowable to one party, but not to the other; or despite identical claim language differences in the disclosures might require that the claims be construed differently.

Rather than copy a claim literally, the better practice is to add (or amend to create) a fully supported claim and then explain why, despite any apparent differences, the claims define the same invention. 37 CFR 41.203(a). The problem of inadequate written description in claims added or amended to provoke an interference is so great that the issue has been singled out for heightened scrutiny early in the course of an interference. 37 CFR 41.201, under "Threshold issue."

Title 37 CFR 41.201 referred in the above passage reads as follows:

Threshold issue means an issue that, if resolved in favor of the movant, would deprive the opponent of standing in the interference. Threshold issues may include:

- (1) No interference-in-fact, and
- (2) In the case of an involved application claim first made after the publication of the movant's application or issuance of the movant's patent:
 - (i) Repose under 35 U.S.C. 135(b) in view of the movant's patent or published application, or
 - (ii) Unpatentability for lack of written description under 35 U. S.C. 112(1) of an involved application claim where the applicant suggested, or could have suggested, an interference under § 41.202(a).

Here, it is submitted that copied claims 1-33 of the child Lamkin '729, which include copied claims 1-24 of the child Lamkin '729 relied on by the Examiner in the rejection of claims 1-24 of the present application over the child Lamkin '729, are not supported by the underlying disclosure of the child Lamkin '729 (i.e., the abstract, the specification, and the drawings of the child Lamkin '729) in the manner required by 35 USC 112, first paragraph, at least for the

reasons discussed above, such that copied claims 1-33 of the child Lamkin '729 are unpatentable to the applicants of the child Lamkin '729 under 35 USC 112, first paragraph, for lack of written description.

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-24 under 35 USC 102(e) as being anticipated by claims 1-24 of Lamkin '729 be withdrawn.

Claim Rejections Under 35 USC 103

Rejection 1

Claims 1-14 and 19-22 were rejected under 35 USC 103(a) as being unpatentable over Landsman et al. (Landsman) (U.S. Patent No. 6,466,967) in view of Silberschatz, Avi, Peter Galvin and Greg Gagne (Silberschatz) ("Applied Operating System Concepts," First Edition, John Wiley & Sons, Inc., 2000, pp. 65-66 and 412-431). This rejection is respectfully traversed.

Claim 1

It is submitted that Landsman and Silberschatz do not disclose or suggest "a buffer which buffers the markup document" as recited in independent claim 1. The Examiner considers column 9, lines 23-55; column 10, lines 5-31; and column 26, lines 43-49, of Landsman to disclose this feature of claim 1, although the Examiner did not indicate which elements discussed in these portions of Landsman allegedly correspond to the "buffer" and the "markup document" recited in claim 1.

However, it is submitted that the only element in the portions of Landsman relied on by the Examiner that may arguably be considered to correspond to the "markup document" recited in claim 1 is the HTML tag which is embedded into a referring page as described in column 10, lines 5-8, of Landsman. However, it is not seen where Landsman discloses or suggests a buffer which buffers this HTML tag. Column 10, lines 16-17, of Landsman indicates that media files are downloaded into a browser RAM cache. However, it is submitted that such media files are not a "markup document" as recited in claim 1. This HTML tag contains a component that downloads a Java applet that in turn downloads advertising files (media and player files) and plays the files on an interstitial basis in response to a user click-stream, that is, when the user

clicks a mouse to transition to a next successive content page. See column 10, lines 5-20 and 45-53, of Landsman. The other component is the web address of an advertising management system from which the advertising files are to be downloaded. See column 10, lines 20-23, of Landsman. However, it is submitted that Landsman's advertising files are not reproduced "in an interactive mode" as recited in claim 1 because the user has no control over which advertising files will be reproduced or when a particular advertising file will be reproduced. In fact, until the first advertising file is reproduced when the user clicks a mouse to transition to a next successive content page, the user will not even be aware that any advertising files have been downloaded because this process is transparent to the user as described in column 10, lines 13-18 and 40-45, of Landsman.

The above arguments were also presented on pages 16 and 17 of the Amendment of March 9, 2007. In response to these arguments, the Examiner states as follows on page 3 of the Office Action of June 6, 2007:

With respect to the claimed markup document, Landsman teaches supplying advertisements as HTML files [col. 5 lines 53 – 55; col. 7 line 29; col. 9 line 24]. Landsman teaches a different way of delivering and presenting the advertisements than the identified prior art, but it appears that HTML is an obvious format to use.

With respect to the claimed interactive mode, Landsman teaches the advertisements are presented based on a user's actions [col. 10 lines 17 – 20].

However, column 5, lines 53-55, and column 7, line 29, of Landsman referred to by the Examiner describe prior-art methods in which advertising HTML files are embedded in a web page. Column 9, line 24, of Landsman referred to by the Examiner, which relates to Landsman's invention, states that "'this new technique should preferably not embed advertising HTML files within a web page" (emphasis added). In light of this, it is submitted that there is no support whatsoever in Landsman for the Examiner's statement that "it appears that HTML is an obvious format to use" since the Examiner's statement contradicts the express disclosure in column 9, line 24, of Landsman referred to by the Examiner. Furthermore, it is submitted that nothing whatsoever in Landsman discloses or suggests that the "advertising HTML files" disclosed in Landsman and referred to by the Examiner are "a markup document" as recited in claim 1 that is used in "reproducing audio video (AV) data . . . in an interactive mode" as recited in claim 1. It is submitted that the mere fact that a document is an HTML document does not make that

document "a markup document" as recited in claim 1 that is used in "reproducing audio video (AV) data . . . in an interactive mode" as recited in claim 1.

Landsman's apparatus implements an AdController agent 420 comprising a Transition Sensor applet 422 and an AdController applet 424 shown in FIG. 5 of Landsman that are implemented through appropriate Java classes and collectively persist, through storage in a browser disk cache 430 shown in FIG. 5, across different content pages within a site, different web sites, and successive browser sessions as described in column 23, lines 4-8, of Landsman. Column 24, lines 16-22, of Landsman describe the AdController agent as follows:

Thus, the agent persists and functions transparently in background, independent and transparent to user navigation across pages on a common web site and across web sites. In that regard, the agent effectively implements a background process which runs in parallel with and is transparent to normal HTML and HTTP operations implemented by the client browser.

It is not understood how Landsman's AdController agent 420, which "functions transparently in background, independent and transparent to user navigation across pages on a common web site and across web sites" as described in this portion of Landsman, can be considered to provide "a markup document" as recited in claim 1 that is used in "reproducing audio video (AV) data . . . in an interactive mode" as recited in claim 1. It is not understood how the Transition Sensor applet 422 and AdController applet 424 included in the AdController agent 420 can be considered to be such a markup document. The AdController agent 420 downloads AdDescriptor files as shown in FIG. 5 of Landsman, which are described as follows in column 21, lines 32-48, of Landsman:

To digress slightly, for the selected advertisement, the AdDescriptor file is a text file that contains a manifest, i.e., a list, of file names and corresponding network locations (URLs) at which these files reside, and player instructions and configuration parameter values necessary to play the entire advertisement through web browser 7 to the user. FIG. 20 shows contents of typical AdDescriptor file 2000 for a PointCast Java advertisement. Specifically and as shown in section 4C of file 2000, this AdDescriptor file lists file names with partial addresses on the ad management system of all media files that constitute content for that advertisement, and, in section 1 of this file, all Java player files necessary to play all the media files. This file also respectively specifies, here shown in section 3 and 4B, an order in which the various media files are to be played, and various configuration

parameters need to properly configure the operation of each player to play each corresponding media file.

It is not understood how the AdDescriptor files or the files listed in the AdDescriptor files can be considered to be "a markup document" as recited in claim 1 that is used in "reproducing audio video (AV) data . . . in an interactive mode" as recited in claim 1.

With respect to the Examiner's statement that "Landsman teaches the advertisements are presented based on a user's actions," the applicants already addressed this point in the arguments on page 13 of the Amendment of March 9, 2007, where the applicants state as follows:

However, it is submitted that Landsman's advertising files are not reproduced "in an interactive mode" as recited in claim 1 because the user has no control over which advertising files will be reproduced or when a particular advertising file will be reproduced.

In fact, until the first advertising file is reproduced when the user clicks a mouse to transition to a next successive content page, the user will not even be aware that any advertising files have been downloaded because this process is transparent to the user as described in column 10, lines 13-18 and 40-45, of Landsman.

However, the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 5, 2007, as required by MPEP 707.07(f).

Furthermore, it is submitted that Landsman and Silberschatz do not disclose or suggest "a buffer manager which manages the buffer to preload the markup document and outputs buffering state information of the buffer in response to a report signal" as recited in claim 1. The Examiner considers column 16, line 56, through column 17, line 9, and column 26, lines 43-49, of Landsman to disclose this feature of claim 1.

Although column 16, line 56, through column 17, line 9, of Landsman relied on by the Examiner describes preloading a Java applet known as an "AdController" agent and media-rich advertising content into a browser disk cache, it is submitted that the Java applet and the media-rich advertising content are not a "markup document" as recited in claim 1. Furthermore, it is not seen where Landsman discloses or suggests preloading Landsman's HTML tag which may arguably be considered to be a "markup document" as recited in claim 1 into the browser disk cache or into any other element that may arguably be considered to be a "buffer" as recited in claim 1, it being noted "preloading" is not the same thing as "loading."

As recognized by the Examiner, Landsman does not disclose "a buffer manager which . . . outputs buffering state information of the buffer in response to a report signal" as recited in claim 1. However, the Examiner is of the opinion that it would have been obvious implement this feature in Landsman's system because column 26, lines 43-49, of Landsman "teaches that the advertisement can not be played until it is fully cached . . . , motivating one of ordinary skill in the art to provide a way to determine if it is cached." The Examiner has relied on page 427, #6-8, of Silberschatz for a general teaching of outputting state information of a buffer.

However, Landsman already provides a way if determining whether an advertisement is fully cached—by loading an ad descriptor file 645 for an advertisement into a play queue 1470 after a browser cache proxy 1450 has finished downloading all media and player files for that advertisement from an agent server 15 as shown in FIG. 14 and described in column 36, lines 31-47, of Landsman. In light of this, it is submitted that there would have been no motivation for one of ordinary skill in the art to implement "a buffer manager which . . . outputs buffering state information of the buffer in response to a report signal" as recited in claim 1 in Landsman's system as a way to determine if an advertisement is cached as proposed by the Examiner.

The above arguments were also presented on page 17 of the Amendment of March 9, 2007. In response to these arguments, the Examiner states as follows on page 3 of the Office Action of June 6, 2007:

With respect to the claimed control information, Landsman teaches the advertisements are presented in response to a trigger if the files are fully cached (state is fully cached) [col. 26 lines 43 – 49; col. 35 lines 11 – 12]. Landsman also teaches providing information about downloading operations [col. 35 lines 3 – 6].

However, these comments by the Examiner merely discuss what Landsman discloses, and do not take note of the above arguments relating to the lack of motivation to combine Landsman and Silberschatz that were also presented in the Amendment of March 9, 2007, and answer the substance of them as required by MPEP 707.07(f), particularly since claim 1 does not recite "control information" as implied by the Examiner in his statement "[w]ith respect to the claimed control information

Column 26, lines 43-49, of Landsman referred to by the Examiner reads as follows:

Transition Sensor events are used to trigger the play of an advertisement only if, by then, all the media and player files for that

advertisement have been fully cached into browser disk cache 430. Otherwise, play of that advertisement is deferred until after all those files are cached and the advertisement is ready to be rendered and, importantly, in response to the next user-initiated transition.

Column 35, lines 11 and 12, of Landsman referred to by the Examiner reads as follows:

when to play a next advertisement fully queued in the Ad Pipeline

Column 35, lines 3-6, of Landsman referred to by the Examiner reads as follows:

In particular, the Ad Loader API provides information regarding and, through setting various program variables, permits programmer control over advertisement display and downloading operations.

However, it is not seen where any of these portions of Landsman disclose or suggest "a buffer manager which . . . outputs buffering state information of the buffer in response to a report signal" as recited in claim 1. Nor has the Examiner explained why he considers these portions to disclose or suggest this feature of claim 1, either alone or in combination with Silberschatz's general teaching of outputting state information of a buffer.

Claim 8

It is submitted that Landsman and Silberschatz do not disclose or suggest the feature "wherein the content decoder generates the report signal using an [obj].isCached(URL, resType) API, where the URL is a parameter indicating a file path of the markup document and the resType is a parameter indicating an attribute of the markup document" recited in dependent claim 8. The Examiner considers column 26, lines 43-49, and column 34, line 66, through column 35, line 18 of Landsman and page 427, #6-8, of Silberschatz to disclose this feature of claim 8. However, it is not seen where these portions of Landsman and Silberschatz disclose or suggest "an [obj].isCached(URL, resType) API" as recited in claim 8. Nor has the Examiner explained why he considers these portions of Landsman and Silberschatz to disclose this feature of claim 8.

The above arguments were also presented on page 18 of the Amendment of March 9, 2007. In response to these arguments, the Examiner states as follows on page 3 of the Office Action of June 6, 2007:

With respect to the API of claim 3 [*sic*: presumably intended to be claim 8], see the response above. Regarding the parameters, Landsman teaches identifying advertisements by file name (attribute) and web address [col. 12 lines 24 – 26].

Column 12, lines 24-26, of Landsman referred to by the Examiner reads as follows:

a list, of: file names and corresponding web addresses of all media files that constitute content for that advertisement

However, it is not seen where this portion of Landsman discloses or suggests "an [obj].isCached(URL, resType) API" as recited in claim 8. Nor has the Examiner explained why he considers this portion of Landsman to disclose or suggest this feature of claim 8.

Claim 19

It is submitted that Landsman and Silberschatz do not disclose or suggest "a buffer manager which manages the buffer to preload the markup document and outputs information of the buffer including buffering information of the markup document, wherein the buffering information includes: information indicating that preloading of the markup document succeeded; information indicating that the preloading of the markup document failed; and information indicating that the preloading of the markup document is still be conducted" as recited in independent claim 19 for at least the same reasons discussed above that Landsman and Silberschatz do not disclose or suggest the similar feature of claim 1.

Conclusion—Rejection 1

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 1-14 and 19-22 (i.e., claims 1, 8, and 19 discussed above and claims 2-7, 9-14, and 20-22 depending from claims 1 and 19) under 35 USC 103(a) as being unpatentable over Landsman in view of Silberschatz be withdrawn.

Rejection 2

Claims 15-18 were rejected under 35 USC 103(a) as being unpatentable over Landsman in view of Silberschatz as applied to claim 2 above, and further in view of Klug et al. (Klug) (U.S. Patent No. 5,996,007). This rejection is respectfully traversed.

It is submitted that Landsman and Silberschatz do not disclose or suggest the feature "wherein the content decoder generates the report signal using a `progressLengthOfFile` API to determine how much of the markup document currently being preloaded has been preloaded" recited in dependent claim 15, or the feature "wherein the content decoder generates the report signal using a `remainLengthOfFile` API to determine how much of the markup document currently being preloaded is yet to be preloaded" as recited in dependent claim 16, or the feature "wherein the content decoder generates the report signal using a `totalLoadingSize` API to determine a total load of the markup document to be preloaded" recited in dependent claim 17, or the feature "wherein the content decoder generates the report signal using a `remainLoadingSize` API to determine how much of a total load of the markup document is yet to be preloaded" recited in dependent claim 18. However, the Examiner considers column 6, lines 5-21, and column 8, lines 6-16, of Klug to teach or imply these features of claims 15-18, and is of the opinion that it would have been obvious to one of ordinary skill in the art to implement these features in the combination of Landsman and Silberschatz proposed by the Examiner "because both teach displaying content, such as advertisements, while other pages are loading, motivating one of ordinary skill in the art to consider combining the teachings of the two disclosures."

However, it is submitted that the mere fact that two references disclose similar features does not, in and of itself, provide the motivation for one of ordinary skill in the art to combine teachings of two references that is required to establish a *prima facie* case of obviousness under 35 USC 103(a).

The above arguments were also presented on page 19 of the Amendment of March 9, 2007. In response to these arguments, the Examiner states as follows on page 3 of the Office Action of June 6, 2007:

Regarding the motivation to combine the teachings used in rejections of claims 15 – 18, teaching similar systems motivates one of ordinary skill in the art to consider using features of each teaching. Furthermore, Landsman also teaches providing information about downloading operations [col. 35 lines 3 – 6].

The Examiner's attention is directed to MPEP 2143, which provides as follows on MPEP page 2100-126 (emphasis by underlining added):

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. (Citation omitted.)

Here, the Examiner has not identified anything whatsoever in Landsman, Silberschatz, and Klug, or in the knowledge generally available to one of ordinary skill in the art, that would have motivated one of ordinary skill in the art to combine Landsman, Silberschatz, and Klug in the manner proposed by the Examiner. Furthermore, the Examiner has not cited any statute, rule, procedure, or decision in support of his position that "teaching similar systems motivates one of ordinary skill in the art to consider using features of each teaching." Rather, it is submitted that the only suggestion that Landsman, Silberschatz, and Klug be combined in the manner proposed by the Examiner is contained in the applicants' disclosure, which MPEP 2143 prohibits the Examiner from relying on as a source for the motivation required to establish a *prima facie* case of obviousness under 35 USC 103. Accordingly, it is submitted that the Examiner has not established a *prima facie* case of obviousness under 35 USC 103.

Furthermore, it is not seen where column 6, lines 5-21, and column 8, lines 6-16, of Klug disclose or suggest "a progressLengthOfFile API" as recited in claim 15, or "a remainLengthOfFile API" as recited in claim 16, or "a totalLoadingSize API" as recited in claim 17, or "a remainLoadingSize API" as recited in claim 18. Nor has the Examiner explained why he considers these portions of Klug to disclose or suggest these features of claims 15-18.

The above arguments were also presented on page 19 of the Amendment of March 9, 2007. In response to these arguments, the Examiner states as follows on pages 3 and 4 of the Office Action of June 6, 2007:

Klug teaches indicating progress and total size [col. 6 lines 10 – 12]. Klug implies indicating remaining size and length by teaching indicating wait time (how much time remains) and identifying size and length as useful units of measure [col. 6 lines 10 – 12; col. 8 lines 6 – 9, 15 – 16].

Claim 6, lines 10-12, of Klug referred to by the Examiner is part of a longer passage in column 6, lines 8-13, of Klug that reads as follows:

Conventionally, during this waiting time period, the user node monitor is inactive except for certain cues to indicate that loading is in progress and, perhaps, indicating the status of the loading process (e.g., indicating the percentage of loading that is complete and the size of the file or other data unit being downloaded).

Column 8, lines 6-9 and 15 and 16 of Klug are part of a longer passage in column 8, lines 6-16, that reads as follows:

If time information is to be utilized (426) the program determines (428) the approximate waiting time associated with a particular web site access request. The approximate waiting time depends on a number of factors including the speed of the server at the selected web site, the level of congestion on the Internet and any rerouting required by such congestion, the bandwidth of each leg of the route between the selected web site and the user node, the processing speed of the user node, the operation of the browser, and the size and number of files that are downloaded before display can begin.

However, it is not seen where column 6, lines 8-13, and column 8, lines 6-16, of Klug, which are reproduced above, disclose or suggest "a progressLengthOfFile API" as recited in claim 15, or "a remainLengthOfFile API" as recited in claim 16, or "a totalLoadingSize API" as recited in claim 17, or "a remainLoadingSize API" as recited in claim 18. Nor has the Examiner explained why he considers these portions of Klug to disclose or suggest these features of claims 15-18.

Furthermore, it is submitted that it would not have been obvious to implement the features described in column 6, lines 5-21, and column 8, lines 6-16, of Klug in the combination of Landsman and Silberschatz proposed by the Examiner because these features would have been of no use in Landsman's advertisement displaying apparatus. Landsman's apparatus simply downloads advertisement media and player files, and when all of the files for an

advertisement have been downloaded, moves an AdDescriptor file for the advertisement into a play queue as discussed above in connection with claim 1.

The above arguments were also presented on pages 19 and 20 of the Amendment of March 9, 2007, but the Examiner did not take note of these arguments and answer the substance of them in the Office Action of June 6, 2007, as required by MPEP 707.07(f).

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 15-18 under 35 USC 103(a) as being unpatentable over Landsman in view of Silberschatz as applied to claim 2 above, and further in view of Klug, be withdrawn.

Rejection 3

Claims 23 and 24 were rejected under 35 USC 103(a) as being unpatentable over Landsman in view of Silberschatz and Lumelsky et al. (Lumelsky) (U.S. Patent No. 6,463,454). This rejection is respectfully traversed.

It is submitted that Landsman, Silberschatz, and Lumelsky do not disclose or suggest "an enhanced navigation (ENAV) buffer which preloads the markup document to reproduce the AV data in the interactive mode" and "an ENAV engine which identifies buffering state information of the markup document and decodes the markup document" as now recited in independent claim 23 for at least the same reasons discussed above that Landsman and Silberschatz do not disclose or suggest the similar features of claims 1 and 19.

Furthermore, although the Examiner considers 4, lines 37-55, of Lumelsky to teach "the use of enhanced audio and video," presumably referring to the "enhanced audio video (ENAV) buffer which preloads the markup document to reproduce the AV data in the interactive mode" previously recited in claim 23, the relevant portion of Lumelsky of this passage in Lumelsky (which is in the Background of the Invention section of Lumelsky) merely reads as follows (emphasis added):

A new breed of high performance applications such as remote surgery, robotics, tele-instrumentation, automated crisis response, digital libraries of satellite data, distance learning via multimedia supported Web sites, enhanced audio, and video, is emerging. However, to accommodate such high performance applications and their continuous media flows, it is not enough to increase or reserve network capacity

This is the only place in Lumelsky that mentions "enhanced audio, and video." In any event, claim 23 now recites "an enhanced navigation (ENAV) buffer which preloads the markup document to reproduce the AV data in the interactive mode," and it is submitted that nothing whatsoever in Lumelsky indicates that the "enhanced audio, and video" referred to in this portion of Lumelsky refers to "an enhanced navigation (ENAV) buffer which preloads the markup document to reproduce the AV data in the interactive mode" as now recited in claim 23.

Furthermore, it is not seen where Landsman, Silberschatz, and Lumelsky disclose or suggest "an enhanced navigation (ENAV) buffer which preloads the markup document to reproduce the AV data in the interactive mode" as now recited in claim 23. The only place the word "interactive" appears in Landsman is in column 2, line 53, in the term "interactive games." The only place the word "interactive" appears in Lumelsky is in column 2, line 33, in the term "interactive instructional presentations."

For at least the foregoing reasons, it is respectfully requested that the rejection of claims 23 and 24 (i.e., claim 23 discussed above and claim 24 depending therefrom) under 35 USC 103(a) as being unpatentable over Landsman in view of Silberschatz and Lumelsky be withdrawn.

Patentability of New Claims 25-27

It is submitted that Lamkin '729, Landsman, Silberschatz, Klug, Lumelsky, and the claims of copending Application Nos. 10/685,694, 10/685,696, 10/685,697, 10/685,699, and 10/686,537 do not disclose or suggest "a reader which reads a preload-list file before the reproducing of the AV data begins" and the feature "wherein the buffer manager manages the buffer to preload the markup document based on contents of the preload-list file before the reproducing of the AV data begins" recited in new dependent claim 25, or the feature "wherein the preload-list file contains information identifying at least one markup document that is to be preloaded into the buffer under the control of the buffer manager before the reproducing of the AV data begins" recited in new dependent claim 26, or the feature "wherein the reader reads the preload-list file from an information storage medium" recited in new dependent claim 27.

For at least the foregoing reasons, it is submitted that new claims 25-27 are patentable over Lamkin '729, Landsman, Silberschatz, Klug, Lumelsky, and the claims of copending

Application Nos. 10/685,694, 10/685,696, 10/685,697, 10/685,699, and 10/686,537, and it is respectfully requested that new claims 25-27 be allowed.

Conclusion

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this paper, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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09/05/07

By: _____



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